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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,285	11/13/2001	Ming-Kang Liu	ITEX 97013C	4204
23694	7590	02/16/2005	EXAMINER	
J. NICHOLAS GROSS, ATTORNEY AT LAW 726 DUBOCE AVE. SAN FRANCISCO, CA 94117			BOAKYE, ALEXANDER O	
			ART UNIT	PAPER NUMBER
			2667	

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. ☒

09/991,285

Applicant(s)

LIU ET AL.

Examiner

ALEXANDER BOAKYE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 0929.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19,21-23,37-43,45,47-55 and 64-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18,19,21-23,48-55 and 64-90 is/are allowed.
- 6) ☒ Claim(s) 1-17,37-43,45,47 and 91-93 is/are rejected.
- 7) ☒ Claim(s) 94-95 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No.6,349,096. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications recite wherein the data routing control circuit routes time sensitive data through the switched network, the digital cross-connect, or some other available data path other than the wide area network with the only difference between the claims of the instant application and the claims of the patent being that the claims of the instant invention recite dialing logic while the claims of the patent does not recite dialing logic. Therefore, it would have been obvious to one of ordinary skill in the art to implement the invention of the instant application using dialing logic in order to perform call setup and tear down.

Claims 37-43, 45 and 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 39 of U.S. Patent No.6,349,096. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications recite wherein the data transfer rates are determined by evaluating a number of separate data links constituting the data route, including a digital subscriber loop connected to the origination and destination sites respectively with the only difference between the claims of the instant application and the claims of the patent being that the claim of the patent recites selection circuit for dynamically evaluating and selecting either or both of a first and second data path based on the availability and data transmission characteristics of such data paths while the claims of the instant application does not recite such limitation. Therefore, it would have been obvious to one of ordinary skill in the art to implement the invention of the instant application using the claims of the patent for the benefit of establishing a data path connection between an originating site and a destination site.

Claims 18, 19, 21-23, 48-55 and 64-90 are allowable.

The following is a statement of reasons for the indication of allowable subject matter: As to claims 18, 19, 21-23, the prior art of record does not teach an access select circuit for setting up a first path and /or a second path as the data path connection based on connection configuration information received from the originating site; and wherein the first path includes a public switched telephone network (PSTN) and /or digital cross-connects (DCS) and the second path includes a wide area network (WAN); a pulse code modulation circuit for converting voice signals from the origination

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site into pulse code modulated voice data suitable for transmission over PSTN switch; and a data access router coupled to and controlled by the access select circuit for routing communications between the originating site and the destination site over the first path and /or the second path; and the data access router being further coupled to PSTN interface, a DCS interface and a WAN interface for transmitting the communications over the first and / or second paths.

As to claims 48-55, the prior art of record does not teach selecting configuring a data route for data transfer to a destination site using first and / or second data paths by determining which of first and second data transmission characteristics best matches the request data transmission characteristics; and transferring data between the originating site and the destination site by using a virtual packet switched circuit connection and / or a virtual permanent circuit connection for the first and / or second data paths respectively.

As to claims 64-69, the prior art of record does not teach a dialing logic circuit for performing call set up and tear down functions for any data paths set up for data communications through the PSTN and / or the DCS.

As to claims 70-75, the prior art of record does not teach routing at least selected time-sensitive portions of the xDSL based signal over the dedicated circuit switched connection between the first CPE and a second CPE using the access system, the selected time-sensitive portions including data for a transfer delay sensitive service; adjusting routing of the xDSL based signal through the WAN and / or the dedicated

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circuit switched connection in response to changes in transfer for delay requirements of the xDSL based signal and / or a request from the first CPE site.

As to claims 76-80, the prior art of record does not teach configuring the access circuit so that at least some portions of the xDSL compatible data transmission from the first origination site can be routed to a plurality of second destination sites using a plurality of separate corresponding PST switch connection; wherein a plurality of separate circuit switched connection are set up in the PSTN for supporting circuit switched data transmissions between the first origination site and the plurality of second destination sites, the circuit switched data transmissions being transported between the first origination site and the access circuit by the xDSL compatible data transmission.

As to claims 81-85, the prior art of record does not teach configuring a data path between the first DSL access circuit and the second DSL access circuit through a dedicated permanent switch connection, including a public switched telephone network (PSTN, to carry data from the first DSL CPE communications device to the second DSL CPE communications device.

As to claims 86-90, the prior art of record does not teach setting up a packet switched connection between the first modem and the second modem using the first access circuit and the second access circuit; wherein a virtual circuit is established over the packet switched network between the first access circuit and the second access circuit in response to the first modem calling the second modem.

Claim Rejections - 35 USC § 102

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2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 91-93 are rejected under 35 U.S.C. 102(e) as being anticipated by Civanlar et al.(US Patent # 5,995,606).

Regarding claim 91, Civanlar teaches a method of operating a data access system comprising the steps of: (a) receiving a telephone call based request for communications service from a first modem (column 5, lines 21-27); (c) processing the telephone call based request to set up a communication connection between the first modem and a second modem, such that when a time sensitive service is required, a dedicated switched circuit is established between the first modem and the second modem (column 3, lines 20-30 ; column 4, lines 54-66; the claimed dedicated switch corresponds to switched network, block 160 of Fig. 2); and when a non-time sensitive service is required, a packet switched path is established between the first modem and the second modem (column 6, lines 63-66).

Regarding claim 92, Civanlar teaches that communications can be sent over both a dedicated switched circuit path and a packet switched path at the same time for the first modem (column 1, lines 33-43).

Regarding claim 93, Civanlar teaches that the first modem is an xDSL modem, the communications connection includes a broadband xDSL signal (Modem 201, Fig. 2 corresponds to the claimed xDSL modem; column 6, lines 16-26).

Allowable Subject Matter

3. Claims 94-95 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Boakye whose telephone number is (571) 272-3183. The examiner can normally be reached on M-F from 8:30am to 6:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (571) 272-3179. The fax number is (703) 872- 9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-4750.

Alexander Boakye

Patent Examiner

AB

10/12/04


CHI PHAM
SUPERVISORY PATENT EXAMINER
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10/18/04